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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION, Plaintiff, - vs. - NEW DESTINY INTERNET GROUP, *et al.*, Defendants.	Case No. C 05-01114 JW (HRL) MDL NO. 1665 **REPLY MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF RECONSIDERATION OF THE COURT'S CONSTRUCTION OF THE TERM "REMOTE LOCATIONS."** Date: September 8-9, 2005 Time: 9:00 a.m. Courtroom: 8, 4th Floor Judge: Honorable James Ware
AND ALL RELATED AND/OR CONSOLIDATED CASE ACTIONS	

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INTRODUCTION

On multiple occasions, and under circumstances demanding both candor and precision, applicants Yurt and Browne expressly defined the term "remote locations" to mean locations remote from the requesting site, not the transmission system. In so doing, the applicants told the public and the PTO what they regarded—and what they did *not* regard—as their invention. No view of the public notice function of the patent system—no matter how constrained—allows a plaintiff, years later in litigation, to urge a contrary position. Acacia, however, asks this Court to ignore these statements based on a salmagundi of arguments that either misapply settled law or mischaracterize incontrovertible facts in an attempt to create confusion about what should be a simple question of claim construction—namely, whether the Court should construe the term "remote locations" as the applicants expressly defined that term before the PTO.

ARGUMENT

I. ACACIA MISCHARACTERIZES DEFENDANTS' ARGUMENT.

Acacia repeatedly mischaracterizes defendants' argument as somehow *requiring* that a transmission system send information *solely* to locations remote from the requesting site. (Acacia Op. Br., pp. 1-7, 10; Transcript of Proceedings, Sept. 9, 2005, pp. 351, 362-63, 369-70.) But that is not what defendants argue. Rather, defendants argue that the transmission system must be *capable* of transmitting information to a location remote from the requesting site. The fact that the transmission system may *also* send information to *unclaimed* locations—such as the requesting site—is irrelevant. Patents typically disclose more than what they claim, and, even when they do not, there is no requirement that each and every claim recite each and every feature of a system. Indeed, as even Acacia concedes, "[e]ven though the patentees described multiple features to their invention, the patentees were not required to include within each of their claims all of these features." (Acacia Op. Br., p. 11 n. 15.)

Defendants' proposed construction is precisely how the applicants defined their invention for more than eight years. The original 1991 application distinguished the invention over known systems, such as U.S. Patent No. 4,506,387 to Walter, because those systems could *not* transmit information anywhere *but* the requesting site.

> The Walter patent discloses a fully dedicated, multi-conductor, optical cable system that is wired to the viewer's premises. While the system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. The Walter system *further requires* the viewer be *at that location for both ordering and viewing* the audio/video material.

('992 patent, col. 1, lns. 18-29 (emphasis added).) In the Petition to Make Special filed during the prosecution of the '992 patent, the applicants again distinguished Walter on the same ground. (Ex. J, p. DTV/AMT 001241.) The 1991 application (and thus the specification) teaches that an object of the invention—not merely one embodiment thereof—is "to provide a picture and sound transmission system which *allows* the user *to remotely select* audio/video material *from any location* that has either telephone service or a computer," such as a mobile phone or an office PC. ('992 patent, col. 1, lns. 62-66 (emphasis added).) More than five years later, in November 1997, the applicants distinguished another known system, U.S. Patent No. 5,195,092 to Wilson, based on the same ground, this time expressly defining the term "remote access":

> *Wilson et al.* teaches a system *significantly different from the present invention*. . . . [I]in *Wilson et al.* the subscriber is *required to be physically present at the location to which information is transmitted*.
>
> In contrast, the *present invention* provides a *flexible* system in which a user *can remotely access* information. *That is,* the user *can* request transmission of information to a site *remote from the requesting site*.

(Ex. G, p. DTV/AMT 001791-92 (emphasis added).) And again, in remarks accompanying an amendment to application claim 33 during the prosecution of the '720 patent, the applicants argued that the term "transmission of data to remote locations" *always* meant the *ability* to transmit information to a location "different from the accessing location" at which a user is positioned when making his or her request:

> In the pending Office Action, commenting on the November 21, 1997, Response filed by Applicants, the Examiner contends that Applicants were relying on features not recited in the pending claims to distinguish the claims from *Wilson*. . . . Applicants disagree because the claimed invention has *always recited transmission of data to remote locations.* This feature is neither disclosed nor suggested in *Wilson*, which requires the subscriber to be physically present at the location to which information is transmitted.
>
> To advance prosecution of this application, Applicants have amended independent claim 33 to *clarify* that the remote location to which the information is transmitted is *different from the accessing location at which the user is positioned when making the request.* As detailed above, this limitation of claim 33 is not disclosed in or suggested by *Wilson*. For at least this reason, independent claim 33 . . . [is] patentable over *Wilson*.

(*Id.*, p. DTV/AMT 001809 (emphasis added).) Finally, two years later in June 1999, or more than eight years after the applicants first distinguished Walter during the prosecution of the '992 patent, the applicants closed the circle and referred back in time to their 1991 distinction over Walter to demonstrate how consistent they had been throughout eight years of prosecution:

> Notably, Applicants have used the term "location" to refer to a *premises*, rather than merely space in a particular structure. For example, Applicants *distinguished* U.S. Patent No. 4,506,387, issued to Walter ("the Walter patent") based upon the fact that the system disclosed in the Walter patent *requires* a dedicated cable wired to the viewer's premises *and that the viewer be at that location for both ordering and viewing* the audio/video material.

(Ex. G, p. DTV/AMT 001844 (emphasis added).)[1]

Thus, for more than eight years, applicants Yurt and Browne consistently described their invention as providing the *ability* to receive information at a location *different* from the

[1] Acacia's opening brief argues that "[w]hen discussing the Walter reference, the patentees do not distinguish their invention from Walter . . . ." (Acacia Op. Brief, p. 9.) But that assertion is expressly contradicted by the statement that "[a]pplicants *distinguished* . . . Walter based upon the fact that the system disclosed in the Walter patent requires a dedicated cable wired to the viewer's premises and that the viewer be at that location for both ordering and viewing the audio/video material. (Ex. G, p. DTV/AMT 001844 (emphasis added).)

requesting site. Acacia's repeated mischaracterization of defendants' argument as *requiring* a transmission system that *always* sends information *solely* to locations remote from the requesting site is a straw man.

II. ACACIA MISREPRESENTS THE SPECIFICATION.

It is certainly true that no embodiment in the common specification *requires* a transmission system *always* to send information *solely* to a location remote from the requesting site, which is why Acacia struggles so hard to characterize defendants' argument as so requiring. But it is equally true that *every* embodiment in the common specification is *capable* of ordering and receiving information at different respective locations. In arguing otherwise, Acacia misrepresents the common specification.

In every embodiment of the invention, the transmission system is identified as numeral 100 and the reception system is identified as numeral 200. Figures 1a-1g show various relationships between these two systems, all of which fall into two categories—(1) connected systems and (2) broadcast systems. In connected systems, the specification expressly teaches that a user may access the transmission system 100 from a location different than the location of reception system 200 to which the information is transmitted and received:

> [T]he user may remotely access the transmission system 100 from *a location different than the location of reception system* 200 where the material will be sent and/or played back. Thus, for example, a user may preferably call transmission system 100 *from work* and have a movie sent to their [*sic*] *house* to be played back after dinner or at any later time of their [*sic*] choosing.

('992 patent, col. 5, lns. 14-22 (emphasis added).) Acacia, therefore, simply misrepresents the specification when it argues that "[n]one of these Figures [1a through 1g] show [*sic*] a user request or a requesting site and none of the Figures show [*sic*] that the information is transmitted to "a location remote from the requesting site." (Acacia Op. Br., p. 4.)

Just as important, the same is true for broadcasting systems, such as in Figure 1g. Acacia argues that "[t]here is no user request" in a broadcast system, and thus a remote location cannot be remote from a requesting site because there is no requesting site in the first instance. (Acacia Op. Br., p. 7.) At the *Markman* hearing, Acacia repeated this argument: "So there's no way for this system to transmit anything to a location remote from a requesting site. It's broadcasting." (Transcript of Proceedings, September 9, 2005, p. 362.) This assertion, too, is untrue. The transmission system of Figure 1g, which teaches "either VHF, UHF or satellite broadcasting systems," is expressly described as transmitting "requested material." ('992 patent, col. 4, lns. 52-63.) Elsewhere we are told that "[i]n *any* of the transmission and receiving systems illustrated in FIGS. la-1g [*i.e.,* including the broadcast systems of Figure 1g], the *requested material* may be copy protected," *i.e.,* there is "requested material" in a broadcast system. ('992 patent, col. 5, lns. 34-36.) Of course, the only "requests" disclosed anywhere in the specification are requests from "users." For example, in both broadcast and connected systems, "a user . . . accesses transmission system 100 by calling a phone number or by typing commands into a computer," and thereafter "chooses audio and/or video material from a list of available items which he or she wants to listen to and/or watch." ('992 patent, col. 3, lns. 54-60.) In this regard, the specification does not even purport to distinguish between broadcast systems and connection systems:

> FIGS. la, 1b, 1d, le, 1f, and *1g* each show transmission system 100, described in more detail below with respect to FIGS. 2a and 2b. A *user* of the transmission and receiving system of the present invention preferably *accesses transmission system 100 by calling a phone number* or by typing commands *into a computer.* The *user* then *chooses* audio and/or video material from a list of available items which he or she wants to listen to and/or watch.

('992 patent, col. 3, lns. 54-60 (emphasis added).) Thus, even in a broadcast system, a user may "access" the transmission system from a mobile or office telephone. Stated differently, although a broadcast system will transmit information to many locations simultaneously, a user is still capable of accessing the system from a location—*e.g.*, a mobile or office phone—that is remote from the location to which the information will be transmitted and received—*e.g.*, his or her living room reception system.

Acacia also points to a "system operator" as an example of an embodiment that does not involve a user request. (Acacia Op. Br., p. 6.) This, too, misrepresents the specification. The patent teaches that a system operator *responds* to user requests made over a telephone, and these user requests may also include the selection of the desired "destination"—*i.e.*, *location*—to which information is transmitted and received:

> Access by the users via operator assisted service includes telephone operators *who answer calls from the users*. . . . Once the chosen program is identified, the operator informs the user of the price. After the user confirms the order, the *user indicates the desired delivery time and destination*. The operator then enters the user request into the system. The request is placed in the transmission queue.

('992 patent, col. 14, lns. 49-63 (emphasis added).) Consequently, not only do operator-assisted systems involve user requests, but a user can also choose between and among "desired destinations" for the receipt of requested information.

Finally, Acacia points to a user terminal interface as an example of ordering and receiving at the same location. (Acacia Op. Brief, p. 8; Transcript of Proceedings, September 9, 2005, p. 363.) True, but irrelevant. The relevant point (which Acacia ignores) is that the user terminal interface also allows a user to select between and among receiving locations. "FIG. 4 is a flowchart of a preferred method of user request via a *user interface* of the present invention. . . . After the desired item is found, the user *selects* the item for transmission at a specific time *and location* (step 4030)." ('992 patent, col. 15, lns. 3-22 (emphasis added).) If a user can "select" between and among multiple receiving locations, *a fortiori* the system can transmit information *either* to the requesting site *or* to a location remote from the requesting site.

Consequently, each and every embodiment of the invention—including broadcasting systems—involves a user request, and each such embodiment permits a user to receive information at a location that is different from the accessing location. Acacia's arguments to the contrary are simply not faithful to the text of the common specification.

III. ACACIA MISCHARACTERIZES THE *MICROSOFT* DECISION.

Apart from being wrong about what the common specification discloses, Acacia also overstates the role of the specification where, as here, an applicant expressly defines a claim term in the course prosecution proceedings. A patent specification is an original part of the initial application for a patent, and thus is the very first statement by the applicant in what often becomes a long and protracted dialogue with the PTO. Not surprisingly, during this dialogue applicants often describe their inventions in ways that are more precise than what they initially disclosed in the application. Consequently, invoking the original application—*i.e.*, the specification—can never exhume subject matter that the applicant disclaimed during the course of prosecution proceedings. (*See* Def. Op. Br., p. 18 n. 9.) For this reason, even if Acacia were correct—and it is not—that the common specification discloses embodiments that *cannot* send information to locations remote from the requesting site, that fact would be irrelevant in light of the applicants' prosecution remarks. The question on this motion is whether the Court may rely on those remarks in construing claim 41 of the '992 patent even though they were uttered during the subsequent prosecution of the '720 patent. The *Microsoft* decision plainly holds that the Court may so rely,[2] and Acacia's efforts to distinguish *Microsoft* do more to mischaracterize that decision than to explain why its holding should not apply with equal force in this case.

Acacia attempts to distinguish *Microsoft* on the ground that the specification in *Microsoft* led to the "inescapable conclusion" that the terms "sending," "transmitting" and "receiving" meant transmission over a telephone line. (Acacia Op. Br., p. 23; Transcript of Proceedings, September 9, 2005, p. 351.) Acacia then concludes that, as a result, the *Microsoft*

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[2] Defendants discuss in detail both the facts and holding of *Microsoft Corp. v. Multi-tech Sys., Inc.*, 357 F.3d 1340 (Fed. Cir. 2004) in their opening brief, and thus do not repeat that discussion here. (*See* Def. Br., pp. 9-17.)

"court could have stopped there" (Transcript of Proceedings, September 9, 2005, p. 352) and did not need to examine, much less rely on, the applicants' later prosecution statements. That argument is both inapplicable and a red herring. The argument is inapplicable because the common specification here, too, leads to the same result as the subsequent prosecution history. (*See supra*, pp. 4-7.) The argument is a red herring because the *Microsoft* panel, whether it needed to or not, in fact relied on the applicant's subsequent prosecution statements as an *independent* basis for its holding. Acacia's reading of *Microsoft* would lead to the absurd rule that prosecution statements are relevant only when they are redundant and duplicative of what is already sated in a specification. That surely is not the law. Prosecution statements have long been held to be *independent* grounds—often the *sole* grounds—for construing claim terms, even where (unlike here) such statements lead to results that would not be compelled by reference to the specification and claims alone. *See, e.g., Springs Window Fashions LP v. Novo Indus. LP*, 323 F.3d 989, 996 (Fed. Cir. 2003) (relying on prosecution statements as an independent basis for claim construction, and stating "we have adopted claim constructions excluding an embodiment when the prosecution history requires the claim construction because of disclaimer"); *Rheox, Inc. v. Entact, Inc.*, 276 F.3d 1319, 1327 (Fed. Cir. 2002) (relying on prosecution history to exclude specific chemical compound disclosed in the specification and falling within plain meaning of the claim).

Acacia next argues that the prosecution statements in *Microsoft* were directed generally to "the invention" in the common specification, whereas the statements at issue in this case were directed to particular claim terms. (Acacia Op. Br. pp. 23-25; Transcript of Proceedings, September 9, 2005, p. 352.) True enough. But that distinction hardly supports Acacia's position. Whereas *Microsoft* involved the *indirect* construction of common *claim terms* based on prosecution statements about "the invention" in a common *specification*, this case involves *both* prosecution statements about "the invention" *and* the *direct* definition of a *common claim term itself*. It makes no sense to hold that prosecution statements discussing a common *specification* are relevant to the construction of common *claim terms*, but that statements *directly defining* a *common claim term itself* are somehow irrelevant. Certainly, nothing in *Microsoft* suggests such an absurd rule, and, indeed, more recent Federal Circuit decisions applying *Microsoft* reach the opposite result. *See, e.g., Datamize, LLC v. Plumtree Software, Inc.*, __ F.3d __, 2005 WL 1845106 (Fed. Cir. Aug. 5 205) (relying upon subsequent prosecution statements defining a common claim term in an ancestral patent, and stating "since the '040 patent is a continuation of the '137 patent, the '040 patent's prosecution history is relevant material that we should consider") (citing *Microsoft*).

Acacia next argues that footnote 5 of the *Microsoft* decision prevents this Court from considering subsequent prosecution statements where they are made in the context of distinguishing the prior art or making an amendment to the application claims. (Transcript of Proceedings, September 9, 2005, p. 352-54.) But that is not what footnote 5 says, as discussed at length in defendants' opening brief. (Def. Br., pp. 12-17.) Footnote 5 simply distinguishes between remarks that are "more specifically" directed to particular features of newly-cited art, on the one hand, and remarks that on their face refer to aspects of "the invention" that are shared in *common* with an ancestral patent, on the other hand. Here, as in *Microsoft*, the applicants made both types of remarks, and here, as in *Microsoft*, it is not difficult to distinguish between the two. Here, in addition to discussing specific features of the prior art, the applicants unambiguously described "the invention," stating that "the *present invention* provides a flexible system in which a user can *remotely access* information. *That is,* the user can request transmission of information to a site *remote from the requesting site*." (Ex. G, p. DTV/AMT 001791-92 (emphasis added).) Here, unlike in *Microsoft*, the applicants went further and specifically *defined* the very claim term that is in dispute, stating that "a remote location to which the information is transmitted is *different from the accessing location at which the user is positioned when making the request*." (*Id.*, p. DTV/AMT 001809 (emphasis added).) These statements do more than discuss specific features of newly-cited art. They define what the applicants regarded—and did not regard—as their invention. These are precisely the sort of statements on which the *Microsoft* panel expressly relied.

Acacia next argues that some—but not all—of the prosecution statements at issue describe an amendment to the claim, which necessarily means that the unamended claim did not already imply the same meaning. (Acacia Br., pp. 20-23; Transcript of Proceedings, September 9, 2005, pp. 357-58, 371.) But that argument fails on two grounds. First, it ignores the applicants' unambiguous *pre*-amendment remarks about what the *unamended* claim already meant: "[T]he *present invention* provides a *flexible* system in which a user can *remotely access* information. *That is,* the user *can* request transmission of information to a site *remote from the requesting site*." (Ex. G, p. DTV/AMT 001791-92 (emphasis added).) Second, Acacia simply ignores the applicants' own remarks about the amendment itself, which they said did nothing more than "clarify" what the naked term "remote location" already meant: "*To advance prosecution* of this application, Applicants have amended independent claim 33 to *clarify* that the remote location to which the information is transmitted is *different from the accessing location at which the user is positioned when making the request*." (*Id.*, p. DTV/AMT 001809 (emphasis added).) Today, Acacia argues that this amendment necessarily narrowed the claim. But that is not what the applicants said. Nor is that conclusion consistent with common sense or applicable law. The claim term "dog," which an applicant defines before the PTO as a best friend having a wet nose and tail, does not change its meaning simply because the words "wet nose and tail" are added by amendment to "advance prosecution" and satisfy an examiner's need for more "clarity." Indeed, the law is otherwise. *See, e.g., Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1377-78 (Fed. Cir. 2001) ("the addition of the words 'transform calculation' was not a narrowing amendment because that addition did nothing more than *make express* what had been *implicit* in the claim as originally worded") (emphasis added). Acacia's post-hoc, litigation-inspired arguments are simply incompatible with how the applicants themselves regarded—and described—the significance of their own amendment. *See Desper Prods*, 157 F. 3d at 1340 ("Post-hoc, litigation-inspired argument cannot be used to reclaim subject matter that the public record in the PTO clearly shows has been abandoned").

Finally, Acacia argues that the examiner twice rejected the applicants' definition of the term "remote location"—thereby necessitating the "clarifying" amendment—and thus the Court should reject the same definition a third time here. (Acacia Op. Br., p. 21-22; Transcript of Proceedings, pp. 358, 375.) But that argument is not a distinction over *Microsoft*. To the contrary, those *are* the facts of *Microsoft*. In *Microsoft*, just as in this case, the examiner rejected the original application claims in view of newly-cited art. In *Microsoft*, just as in this case, the applicant disagreed with the examiner and explained that claims reciting specific words (*i.e.,* "sending," "transmitting," and "receiving") implied a special meaning (*i.e.*, over a telephone line). In *Microsoft*, just as in this case, the examiner expressly disagreed and rejected the application claims for the second time. In *Microsoft*, just as in this case, the applicant then amended the claim (*i.e.,* by adding the word "modem"). And in *Microsoft*, just as in this case, the fact that the examiner twice disagreed with the applicant's definition of a claim term, and required an express amendment to the claim, was irrelevant. 357 F.3d at 1350 ("We have stated on numerous occasions that a patentee's statements during prosecution, whether relied on by the examiner or not, are relevant to claim interpretation). *See also Seachange Int'l, Inc. v. C-Cor, Inc.*, __ F.3d __, 2005 WL 1523382 (Fed. Cir. June 29, 2005) ("The fact that the Examiner did not indicate reliance on the [applicant's statements] is of no consequence. An applicant's argument made during prosecution may lead to a disavowal of claim scope even if the Examiner did not rely on the argument"); *Springs Window Fashions.*, 323 F.3d 989, 994-95 (relying on prosecution statements as independent grounds for claim construction, and rejecting plaintiff's argument that "the examiner did not agree that the amended claims distinguished over [the prior art] and that the claims therefore should not be limited based on the applicant's argument that they did");

Laitram Corp. v. Morehouse Industries, Inc., 143 F.3d 1456 (Fed. Cir. 1998), 143 F.3d at 1462 ("The fact that an examiner placed no reliance on an applicant's statement distinguishing prior art does not mean that the statement is inconsequential for purposes of claim construction").

IV. ACACIA CONFUSES PROSECUTION HISTORY ESTOPPEL WITH CLAIM CONSTRUCTION.

Claim construction defines individual claim terms and is related to questions of literal infringement. By contrast, prosecution history estoppel asks whether infringement may occur under the doctrine of equivalents where one or more previously-defined claim terms is lacking in an accused product or method. Confusion can arise because an applicant's prosecution statements can be relevant to both questions. *See, e.g.*, *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1221 (Fed. Cir. 1996) ("Just as prosecution history estoppel may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction . . ."). But they are treated differently. The task of claim construction asks whether the applicants defined a specific claim term during prosecution. Prosecution history estoppel involves an analysis of the scope of the prior art to determine the range of equivalents to which a patentee may be entitled. As the Federal Circuit has explained under similar circumstances, questions involving prosecution history estoppel are "simply irrelevant" to claim construction:

> Southwall seems to imply that principles of prosecution history estoppel are relevant in the claim construction step of a determination of literal infringement. There is, however, a clear distinction between following the *statements* in the prosecution history in *defining a claim term*, and the doctrine of prosecution history estoppel, which limits expansion of the protection under the doctrine of equivalents when a *claim has been distinguished over relevant prior art.* [Citation omitted.] Claim interpretation in view of the prosecution history is a preliminary step in determining literal infringement, while prosecution history estoppel applies as a limitation on the range of equivalents if, after the claims have been properly interpreted, no literal infringement has been found. [Citation omitted.] The limit on the range of equivalents that may be accorded a claim due to prosecution history

estoppel is *simply irrelevant* to the interpretation of those claims.

Southwall Tech., v. Cardinal IG Co., 54 F.3d 1570, 1578 (Fed. Cir. 1995) (emphasis added).

Here, Acacia makes a number of arguments that simply confuse claim construction with prosecution history estoppel. For example, Acacia argues that the applicants distinguished Walter on more than one ground, and thus no one ground can create its own estoppel. (Acacia Op. Br., pp. 15-16; Transcript of Proceedings, September 9, 2005, p. 367.) Acacia also argues that the amendment to application claim 33 did more than merely "clarify" the meaning of the term "remote locations" because it added still other limitations to overcome the Wilson reference. (Transcript of Proceedings, September 9, 2005, pp. 358-60, 368-72.) These arguments are "simply irrelevant" to claim construction. What is relevant to claim construction is whether the applicants defined a specific *claim term*, not whether other distinctions could have been (or were) made between *other aspects of the claim* and the prior art.

Similarly, the fact that application claim 33 was later cancelled, and thus did not issue, is also irrelevant. The Federal Circuit routinely relies on prosecution statements regarding cancelled claims both to construe common terms in, and to determine the range of equivalents of, issued claims. *See, e.g., Southwall,* 54 F.3d at 1579 (relying on prosecution statements in cancelled claims to construe common terms in, and determine scope of equivalents of, issued claims, and stating "[w]hether claim 14 derived from any application claim discussed in the prosecution history is irrelevant to our interpretation of claim 14 in light of that history"); *Desper Prods., Inc. v. QSound Labs, Inc.*, 157 F.3d 1325 (Fed. Cir. 1998) (relying on prosecution statements defining terms in cancelled claims to construe common terms in issued claims); *American Permahedge v. Barcana, Inc.*, 105 F.3d 1441, 1446 (Fed. Cir. 1997) (prosecution statements regarding cancelled claims created prosecution history estoppel as to issued claims). As the Federal Circuit explained in *Desper Prods.*, the critical question is whether an applicant has defined a claim term, not what happened to the claim thereafter—*i.e.,* whether it was amended further or cancelled altogether:

> [Plaintiff] further argues that the attorney's remarks should not be used to interpret the claim language because the amendment that precipitated the remarks did not end the prosecution. In effect, [plaintiff] argues that the remarks were inconsequential because they did not result in allowance of the claims. . . . What [plaintiff] fails to acknowledge, however, is that the amendment and accompanying remarks were made for the purpose of overcoming the outstanding rejection based on the [cited art]. That the prosecution shifted to a different focus does not blunt the impact of those remarks made to overcome the prior rejection. The significance of the remarks in this case is no different than in a case in which the claims are allowed in response to an amendment.

157 F.3d at 1335-36 (emphasis added); *see also Southwall*, 54 F.3d at 1584 ("[T]hat [plaintiff] might have made the arguments distinguishing [the prior art] with regard to versions of the claims not now at issue does not avoid those arguments limiting later or different versions of the claims").

V. ACACIA'S PROPOSED CONSTRUCTION WOULD DO VIOLENCE TO THE PUBLIC NOTICE FUNCTION OF THE PATENT SYSTEM.

For eight years, applicants Yurt and Browne consistently defined their invention as capable of transmitting information to locations remote from the requesting site. In so doing, they used words of express lexicography—such as "that is"—which is short for the expression "that is to say" or "in other words." These statements did more than merely describe the prior art. These statements did more than merely describe "the invention" that was disclosed in the specification. These statements expressly defined a claim *term*. The public is surely entitled to rely on these statements, and it makes absolutely no difference that the application claim at issue was amended further only to be cancelled altogether. (*See supra*, pp. 13-14.) No view of the public notice requirement of the patent system allows a patentee—once in litigation—to urge the very construction that the applicants rejected at every opportunity for more than eight years. *See Microsoft*, 357 F.3d at 1350 ("We take the patentee at his word and will not construe the scope of the . . . patent more broadly than the patentee itself clearly envisioned"); *Desper Prods*, 157 F.3d at 1337 (stating that "the public has the right to rely on the applicants' remarks in seeking allowance of their claims" as to claims that were ultimately cancelled); *Springs Window Fashions*., 323 F.3d at 995 ("The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent").

CONCLUSION

For the foregoing reasons, and for the reasons set forth in defendants' opening brief, the Court should reconsider its prior construction of the term "remote locations" and construe that term to mean "positions or sites distant in space from the requesting location."

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